

**REMARKS**

In the December 19, 2006 Office Action, the Examiner noted that claims 1, 2, 4, 6 and 8-18 were pending in the application; rejected claims 10, 11, 17 and 18 under 35 USC § 101; rejected claims 1, 2, 8-12 and 15-18 under 35 USC § 102(b); and rejected claims 4, 6, 13 and 14 under 35 USC § 103(a). In rejecting the claims, U.S. Patents 5,802,518 to Karaev et al. (Reference A in the June 9, 2006 Office Action); 6,717,938 to D'Angelo; and 6,563,517 to Bhagwat et al. (References B and C, respectively, in the May 6, 2005 Office Action) were cited. Claims 1, 2, 4, 6 and 8-18 remain in the case. The rejections are traversed below.

**Rejections under 35 USC § 101**

In items 9-10 on pages 2-3 of the December 19, 2006 Office Action, claims 10, 11, 17 and 18 were rejected under 35 USC § 101 as allegedly directed to non-statutory subject matter. In a telephonic interview on April 12, 2007, the Examiner acknowledged that MPEP § 2106 does not support the rejection and identified the Interim Guidelines published November 22, 2005 in the Official Gazette as the reason for the rejection. It is submitted that these Guidelines have no legal effect and no changes should have been required. However, an attempt has been made to amend the specification as suggested by the Examiner. Therefore, reconsideration of the rejections under 35 USC § 101 is respectfully requested. If these amendments are insufficient, the Examiner is respectfully requested to contact the undersigned by telephone to discuss what further changes are necessary to meet the extra-legal requirements of the Interim Guidelines.

**Rejections under 35 USC § 102**

In items 12-14 on pages 3-6 of the December 19, 2006 Office Action, claims 1-3, 8-12 and 15-18 were rejected under 35 USC § 102(b) as anticipated by Karaev et al. The independent claims have been amended to recite that "the provision format include[s] a portable document format which is converted from provision information at the terminal device" (e.g., claim 1, lines 7-9) which is consistent with the example described in the paragraph beginning at page 15, line 13, of the application. In rejecting claim 1, it was asserted that column 3, lines 34-39 of Karaev et al. discloses that "the provision format include[s] a portable document format which is converted from provision information and an original format which is not converted from provision information" (Office Action, page 4, lines 12-13). Furthermore, in the "Response to Arguments" on pages 9-11 of the December 19, 2006 Office Action, it was asserted that Karaev et al. at "column 3, lines 34-39, shows the ability of the system to convert files into PDF format" (Office Action, page 10, lines 6-7). However, as discussed in the Amendment filed October 10,

2006 (received by the U.S. Patent and Trademark Office on October 12, 2006), Karaev et al. discloses a system in which "files received from the contributor work stations are converted at a central site into [a] predetermined format" (column 3, lines 34-35). Nothing has been cited or found in Karaev et al. suggesting that the conversion occurs "at the terminal device" as now recited in each of the independent claims.

The difference in location of conversion should be sufficient to overcome the anticipation of the claims by Karaev et al. However, it is submitted that there is more to the difference between the invention and Karaev et al. and that as a result, what is recited in the independent claims is not obvious from Karaev et al. Specifically, both the rejection of claim 1 and the "Response to Arguments" cited column 6, lines 21-43 (as well as column 1, lines 38-47 and column 4, lines 55-63) as "show[ing] the acceptance of report information by contribution servers and a central site ... [and] utiliz[ing] a document profile (report information) to determine the format for the file" (Office Action, page 10, lines 11-13). However, the cited portions of Karaev et al. do not refer to "the format for the file", but rather that "the information provider may require that the format of the information provided to one user be different from the format of the same information provided to another user or class of users" (column 1, lines 37-41). Similarly the cited portion of column 4 refers to "template forms, for each type of query, for each user or class of user, etc. Thus, each user or class of users may receive information in a format defined for that user or class of users" (column 4, lines 56-59). The term "template forms" is used to refer to "the output format of the information provided to users" (column 4, lines 61-62) which use is described as advantageous, because it is possible to use "[t]emplate forms ... without having to 'hardcode' any program" (column 4, lines 63-64).

In other words, Karaev et al. uses the word "format," at least in column 4, to refer to the arrangement of data being output and thus, is closer to the first definition of "format" at Merriam-Webster Online ([www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=format](http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=format)), "the shape, size, and general makeup (as of something printed)" rather than the third definition, "a method of organizing data (as for storage) <various file formats>." Clearly, it is the third definition of "format" that is the definition used by the claims which recite that "the provision format includes a portable document format" (e.g., claim 1, lines 7-8) and the specification states that one example of a portable document format is the well-known data storage format produced by Adobe Acrobat (see the paragraph starting at page 15, line 13). These same distinctions can be found at ([dictionary.cambridge.org/define.asp?key=30628&dict=CALD](http://dictionary.cambridge.org/define.asp?key=30628&dict=CALD)) the online Cambridge Advanced Learner's Dictionary in the first definition of "format" as a verb, "to organize or arrange text,

especially on a computer, according to a chosen pattern" and the second definition of "format" as a noun, "the way in which information is arranged and stored on a computer."

It is submitted that one of ordinary skill in the art would not find it obvious to specify a data storage format for recipients in the manner recited in the claims from the disclosure in Karaev et al. of template forms defining the arrangement of data output to users. Limitations similar to those quoted above from claim 1 are recited in the other independent claims. Therefore, it is submitted that independent claims 1, 2, 8-12 and 15-17, as well as claim 18 which depends from claim 17, patentably distinguish over Karaev et al.

### **Rejections under 35 USC § 103**

In items 16-19 on pages 6-8 of the December 19, 2006 Office Action, claims 4 and 13 were rejected under 35 USC § 103(a) as unpatentable over Karaev et al. in view of the D'Angelo. Claim 4 depends from claim 2 and claim 13 depends from claim 12. Nothing was cited or has been found in D'Angelo suggesting modification of Karaev et al. to overcome the deficiencies of Karaev et al. discussed above. Therefore, it is submitted that claims 4 and 13 patentably distinguish over the combination of Karaev et al. and D'Angelo for the reasons discussed above with respect to claims 2 and 12.

In items 20-23 on pages 8-9 of the December 19, 2006 Office Action, claims 6 and 14 were rejected under 35 USC § 103(a) as unpatentable over Karaev et al. in view of Bhagwat et al. Claim 6 depends from claim 2 and claim 14 depends from claim 12. Nothing was cited or has been found in Bhagwat et al. suggesting modification of Karaev et al. to restrict access by format of information provided to users. Therefore, it is submitted that claims 6 and 14 patentably distinguish over Karaev et al. in view of Bhagwat et al. for at least the reasons discussed above with respect to claims 2 and 12.

### **Summary**

It is submitted that the references cited by the Examiner do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-2, 4, 6, 8-18 are in a condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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